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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/602,128 | 06/24/2003 | Brian L. Wilt | KMC / 302US | 1590 |

26875 7590 05/17/2005

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| EXAMINER | |
|---|---|
| NGUYEN, THONG Q | |
| **ART UNIT** | **PAPER NUMBER** |
| 2872 | |

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H·A

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/602,128 | WILT ET AL. | |
| | Examiner | Art Unit | |
| | Thong Q. Nguyen | 2872 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 January 2005 and 28 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *12 and 13* is/are allowed.

6)☒ Claim(s) *1-3 and 6-11* is/are rejected.

7)☒ Claim(s) *4-5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/19/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb. 28, 2005 has been entered.

### *Response to Amendment*

2. The present Office action is made in response to the amendment filed on 1/26/2005 and the Declaration filed under 37 CFR 1.132 on 2/28/2005.

It is noted that in the mentioned of 1/26/2005, applicant has made changes to the specification and the claims. Regarding to the specification, applicant has amended sections [0029] and [0035] and Tables 1 and 2. Regarding to the claims, applicant has amended claims 4-5 and 12-13. It is also noted that the present Office action is also taken into consideration the changes to the specification and the claims by the amendment filed on 9/10/2004 as requested by the applicant in the request for continued examination under 37 CFR 1.114 filed on 2/28/2005.

### *Specification*

3. The disclosure is objected to because of the following informalities: Page 12, section [0037], line 1, "anther" should be changed to –another--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 and 8-10, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada (U.S. Patent No. 4,865,438, of record) in view of Kelman (U.S. Patent No. 4,833,890, of record).

Wada discloses an optical device having a magnification loupe attached to an eyeglass. The device as described in columns 1-4 and shown in figures 1-2 and 4-5 comprises the following components: 1) An eyeglass having a frame (1) supporting a pair of prescription lenses (2) wherein the prescription lenses are able to change for a different set of prescription lenses based on intended use or working distance. It is also noted that the prescription lenses can select from a group of lenses having curved surfaces or non-curved surfaces. See column 2, lines 55-60; and 2) a magnification loupe (10) comprises a pair of monoculars (11) which are removably attached to the eyeglass frame via a mechanism (12). Each of the monoculars (11) comprises a housing (13) having a first end supporting a movable eyepiece lens (15) and a protective element (23) and a second end supporting an objective lens (14) and a protective element (17). The objective lens has a non-circular shape having two oppositely peripheral edges defined by a first radius from a first center, and the remaining two oppositely peripheral edges defined by a second radius extending from a second center not coincident with the first center wherein the second radius has a length different

from the first radius. Regarding to the feature relating to the connection of the magnification loupe to the eyeglass, it is noted that in columns 2-3, Wada discloses the use of a mechanism (12) for coupling the pair of the monoculars to the bridge of the eyeglass frame, and each lens (2) of the eyeglass has a bore for allowing the end of the housing of each monocular go through.

As a result, the optical device as provided by Wada meets all of the features of the device claimed except the feature related to the arcuate shape of the peripheral surfaces of the objective lens element. In other words, while the vertical surfaces of the objective lens provided by Wada have arcuate shape; however, the horizontal surfaces of the objective lens have not arcuate shape as claimed.

However, the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010}. In other words, the change in shape of the lens used in the device does not affect to the performance of the device. In that viewpoint, then the non-circular objective lens used in the magnification viewer provided by Wada meets the advantage related to the reduction in weight of the lens. Further, the use of a lens having a non-

circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. See column 8 and fig. 6. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and shown in figure 1.It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See In re Dailey, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Wada by using an objective lens element having a non-circular shape in which the horizontal peripheral surfaces of the lens element have accurate shape as suggested by Kelman for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer.

6. Claims 1-3, 6, 8 and 10, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom (U.S. Patent No. 3,273,456, of record) in view of Kelman (U.S. Patent No. 4,833,890, of record)

Feinbloom discloses an optical device having a magnification loupe attached to an eyeglass. The device as described in columns 1-3 and shown in figures 1-4

and 6 comprises the following components: 1) an eyeglass having a frame with a bridge (14) supporting a pair of lenses (16). It is noted that each lens of the eyeglass frame as shown in figure 2 has a non-curved surface; and 2) a magnification device comprises a pair of monoculars (18) which are removably mounted through a corresponding lens of the eyeglass. See figures 1-2.

Each of the monoculars (18) comprises a housing (20) having a first end supporting a single eyepiece lens (III) and a correction lens (22) and a second end supporting a two-element objective lens (I, II). The objective lens has a non-circular shape having two oppositely peripheral edges defined by a first radius from a first center, and the remaining two oppositely peripheral edges each defined by a second radius extending from a second center not coincident with the first center wherein the second radius has a length different from the first radius.

As a result, the optical device as provided by Feinbloom meets all of the features of the device claimed except the feature related to the arcuate shape of the peripheral surfaces of the objective lens element. In other words, while the vertical surfaces of the objective lens provided by Feinbloom have arcuate shape; however, the horizontal surfaces of the objective lens do not have arcuate shapes as claimed.

However, the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in

page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010}. In other words, the change in shape of the lens used in the device does not affect to the performance of the device. In that viewpoint, then the non-circular objective lens used in the magnification viewer provided by Feinbloom meets the advantage related to the reduction in weight of the lens. Further, the use of a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. See column 8 and fig. 6. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and shown in figure 1.It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See In re Dailey, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Feinbloom by using an objective lens element having a non-

circular shape as suggested by Kelman for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer.

7. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom in view of Kelman as applied to claims 6 and 10 above, and further in view of Caplan et al (U.S. Patent No. 6,061,189, of record).

The combined product having a magnification loupe coupling to an eyeglass as provided by Feinbloom and Kelman does not explicitly state that the correction lens is able to replace with other correction lens of different optical characteristics for the purpose of varying a working distance. However, the use of a magnification loupe coupled to an eyeglass frame wherein the housing of the loupe supporting an eyepiece lens and a correction lens which lenses are able to replace with different set of eyepiece lens and correction lens for the purpose of varying working distances is known to one skilled in the art as can be seen in the through the lens binocular viewer provided by Caplan et al. See columns 4-5 and fig. 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the optical device provided by Feinbloom and Kelman by changing the correction lens whenever an eyepiece lens is changed as suggested by Caplan for the purpose for adjusting the working distances as well as the contrast.

***Allowable Subject Matter***

8. Claims 12-13 are allowed.

9. Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The device as claimed in each of claims 4-5 and 12-13 is patentable with respect to the prior art by the limitations related to the specific optical numerical data related to the lens elements constituted the device.

***Response to Arguments***

11. Applicant's arguments filed on 1/26/2005 have been fully considered but they are not persuasive for the following reasons.

A) Regarding to the objection to the specification under 35 U.S.C. 132 and the rejections of claims 4-5 and 12-13 under 35 USC 112, first paragraph, the amendments to the claims as filed on 1/26/05 and the Declaration filed on 2/28/05 are sufficient to overcome the objections to the specification and the rejection to the claims.

B) Regarding to the rejections of claims 1-13 under 35 USC 112, first paragraph, applicant's arguments provided in the amendment of 1/26/05, pages 15-18, have been fully considered but they are not persuasive.

B) Regarding to the rejection of claims 1 and 8-10 under 35 USC 103(a) over the art of Wada and Kelman, applicant's arguments provided in the amendment of

1/26/05, pages 18-20, have been fully considered but they are not persuasive for the following reasons.

First, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each Wada and Kelman discloses a lens element for use with another optical system wherein the lens element has a non-circular shape. As stated in the rejection, the only feature missing from the art of Wada is that he does not state that the horizontal peripheral edges of the lens have

arcuate shapes as claimed in the present claims. However, the rejection has also emphasized that the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010}. In other words, the change in shape of the lens used in the device does not affect to the performance of the device. In that viewpoint, then the non-circular objective lens used in the magnification viewer provided by Wada meets the advantage related to the reduction in weight of the lens. The art of Kelman is used in the rejection to show that a lens element having its horizontal curved/arcuate peripheral edges used in combination with other optical device is known to one skilled in the art. In particular, in column 8 and fig. 6, Kelman teaches a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and

shown in figure 1.It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See In re Dailey, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Wada by using an objective lens element having a non-circular shape in which the horizontal peripheral surfaces of the lens element have accurate shape as suggested by Kelman for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer.

C) Regarding to the rejection of claims 1-3, 6, 8 and 10 under 35 USC 103(a) over the art of Feinbloom and Kelman, applicant's arguments provided in the amendment of 1/26/05, pages 20-21, have been fully considered but they are not persuasive for the following reasons.

First, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each Feinbloom and Kelman discloses a lens element for use with another optical system wherein the lens element has a non-circular shape. As stated in the rejection, the only feature missing from the art of Feinbloom is that he does not state that the horizontal peripheral edges of the lens have arcuate shapes as claimed in the present claims. However, the rejection has also emphasized that the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010}. In other words, the change in shape of the lens used in

the device does not affect to the performance of the device. In that viewpoint, then the non-circular objective lens used in the magnification viewer provided by Wada meets the advantage related to the reduction in weight of the lens. The art of Kelman is used in the rejection to show that a lens element having its horizontal curved/arcuate peripheral edges used in combination with other optical device is known to one skilled in the art. In particular, in column 8 and fig. 6, Kelman teaches a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and shown in figure 1.It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See In re Dailey, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Feinbloom by using an objective lens element having a non-circular shape in which the horizontal peripheral surfaces of the lens element

have accurate shape as suggested by Kelman for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer.

D) Regarding to the rejection of claims 7 and 11 under 35 USC 103(a) over the art of Feinbloom, Kelman and Caplan et al, applicant's arguments provided in the amendment of 1/26/05, pages 21-22, have been fully considered but they are not persuasive.

It is noted that in the arguments, applicant has argued that the art of Caplan does not cure the deficiencies because Caplan et al disclose a circular objective lens. While the Examiner has agreed to the applicant's opinion about the shape of the objective lens disclosed in the art of Caplan et al; however, applicant is respectfully invited to review the rejection in which the art of Caplan et al used in the rejection is for the purpose of showing one skilled in the art the use of different correction lenses having different optical characteristics for the purpose of varying a working distance and for the purpose for adjusting the working distances as well as the contrast.

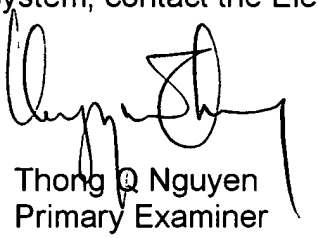
***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
Art Unit 2872

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